

## **REMARKS**

Claims 23-44 are pending in the present application.

### **Restriction Requirement**

The Examiner has required election in the present application between:

Group I, claims 23-39, drawn to a processing apparatus for fluid, classified in class 239, subclass 461;

Group II, claims 40-43, drawn to a deaerator, classified in class 96, subclass 196; and

Group III, claim 44, drawn to a processing method for a fluid, classified in class 239, subclass 1.

**For the purpose of examination of the present application, Applicant elects, with traverse, Group I, Claims 23-39.** However, it is respectfully requested that the Examiner reconsider and withdraw the restriction requirement for the following reasons.

First, Applicant submits that the claims of Group I are not properly restrictable from the claims of Group II. Specifically, each of the independent claims 23 and 35 include dispersion, and therefore the dependent claims 40-43 include dispersion due to their respective dependence on independent claims 23 and 35. In view of this, the Examiner's position that "the combination as claimed does not require the particulars of the subcombination as claimed because the combination claim does not require dispersion" is without merit. In addition, since the combination claims 40-43 require dispersion, there is no separate utility for the subcombination "as claimed."

Since the Examiner has not shown two (2) way distinction for the above reasons, Applicant submits that claims 40-43 should be examined along with the claims of elected Group I.

With regard to the Examiner's restriction of the process claim 44, Applicant also submits that the claims of Group I are not properly restrictable from the claims of Group III. Specifically, the process claim 44 requires substantially every element of the apparatus claim 23. In view of this, the Examiner's position that the apparatus could be used for deaeration is without merit.

It should be noted that distinction can only be shown by reviewing the claims. In the present situation, the Examiner has taken the position that the apparatus "could" be used for deaeration. However, deaeration does not appear in independent claim 23. As recognized by the Examiner, one (1) way distinction is required to restrict between a process and apparatus. Specifically, distinction can be shown if "(1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process." (emphasis added). Since the Examiner has not relied on the claimed apparatus and process, Applicant submits that the Examiner has not shown one (1) way distinction.

#### **Election of Species Requirement**

The Examiner also requires an election between the following species:

Species I: dispersion;

Species II: emulsification;

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Species III: mixing;

Species IV: grinding;

Species V: attrition; and

Species VI: atomization.

**For the purpose of Examination of the present application, Applicant elects, with traverse, Species VI, atomization. Applicant submits that all of claims 23-39 are readable on the elected species. However, for the above-explained reasons, it is believed that the Examiner's Restriction Requirement is improper. Therefore, Applicants submit that all of claims 23-44 are readable on the elected species.**

In the Examiner's Office Action, the Examiner indicates that no claims are generic. Applicant respectfully submits that the Examiner's position is incorrect. Independent claims 23, 35 and 44 recite each one of the processes of dispersion, emulsification, mixing, grinding, attrition and atomization. Therefore, all of claims 23-44 are generic to the present invention.

In order to be responsive to the Examiner's Election of Species Requirement, Applicant has elected Species VI, claims 23-39, which are directed to atomization. It is respectfully submitted that a reasonable number of species are permitted in a single application. The present application contains six species. However, Species I-VI (dispersion, emulsification, mixing, grinding, attrition and atomization) all appear in independent claims 23, 35 and 44. In addition, none of the dependent claims specify any of the particular processes of dispersion, emulsification, mixing, grinding, attrition and atomization. It is therefore respectfully submitted that the Examiner's Election of Species Requirement is improper in view of the fact that a reasonable number of species are set forth in the present application.

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Applicant also respectfully submits that a burden has not been established by the Examiner. Specifically, the Examiner is presenting an Election of Species Requirement to select one of the Species I-VI when there are no claims directed to the individual species of dispersion, emulsification, mixing, grinding, attrition and atomization. In view of this, Applicant respectfully submits that the Examiner's Election of Species Requirement is premature. Applicant should not be expected to elect a single species for prosecution, when no claims are directed to a particular species, but are readable on all of the Species mentioned by the Examiner. In view of this, it is requested that the election of species requirement be withdrawn until a particular claim is directed to one of the species I-VI.

Favorable action on the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Paul C. Lewis, Registration No 43,368 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

- ☒ Attached is a Petition for Extension of Time.
- ☒ Attached hereto is the fee transmittal listing the required fees.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: September 20, 2005

Respectfully submitted,

By 

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